

Remarks

Upon entry of the foregoing amendments, claims 117-220 are pending in the application, with claims 117, 127, 135, 143, 151, 160, 176, 184, 191, and 210 being the independent claims. Amendments to claims 118, 119, 152, 161, 169, 176, 184, 194, 198, 200, 202, 203 and 210 are sought. Claims 117, 120-175, 191-197, 199, 201 and 203-209 were previously allowed by the Examiner in the Office Action of March 11, 2003.

The foregoing amendments to the claims are in response to the Examiner's objections and rejections, and are believed to place the claims into condition for allowance or into better condition for consideration on appeal. Support for the foregoing amendments to the claims may be found throughout the description, and in the original claims. Support for the claims can be found, *inter alia*, at page 25, line 1 to page 33, line 4, in Examples 5 and 6 (pages 65 to 67), and Figures 2 and 5. No new claims are sought to be added. These amendments do not raise new issues or require further search by the Examiner. These changes are believed to introduce no new matter, and their entry is respectfully requested. Reconsideration of this Application is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Objections to the claims

The Examiner objected to claims 198, 200 and 202 for omitting the word "sequence" after "amino acid." (Paper No. 12, at 2.) In response to the objection, Applicants have added the term "sequence" after "amino acid" in claims 198, 200 and 202, thereby obviating the Examiner's objection.

The Examiner objected to claims 118 and 119 as being of improper dependent form for failing to further limit the subject matter of a previous claim. (Paper No. 12, at 3.) Applicants respectfully disagree, as Applicants believe that claims 118 and 119 are in proper dependent form. However, to more clearly state their dependencies, Applicants have amended claims 118 and 119. Claim 117 is drawn to an isolated polypeptide comprising amino acids 1 to 233 of SEQ ID NO:2. Amended claim 118 is drawn to the polypeptide of claim 117, and further comprises additional amino acids -25 to 1, inclusive. Claim 119 is drawn to the polypeptide of claim 118, and further comprises additional amino acid -26. Thus, both claims 118 and 119 recite additional amino acids compared to their respective base claims. Since amended claims 118 and 119 are in proper dependent form, withdrawal of this objection is respectfully requested.

Rejections under 35 U.S.C. § 112, first paragraph, written description

The Examiner rejected claims 176-190 and 210-220 under 35 U.S.C. § 112, first paragraph, for alleged lack of written description. (Paper No. 12, at 3.) The Examiner retained the original grounds of rejection and deemed Applicant's arguments nonpersuasive. However, the Examiner found persuasive Applicant's arguments "for polypeptides 90% to 95% identical to the polypeptide of SEQ ID NO:2, and for polypeptides comprising the

major domains of the polypeptides that have the activity of binding TRAIL." (Paper 12, at 6.)

The Examiner further argues that "[f]ollowing Applicants' arguments, a polypeptide comprising 10, 5 or even 2 amino acids of the polypeptide of SEQ ID NO: 2 would also be adequately described, as long as the polypeptide bound an antibody with specificity for a reference polypeptide consisting of SEQ ID NO: 2, and these polypeptides require virtually no structure." (Paper No. 12, at 5.) Applicants respectfully disagree.

Claims 176-190 and 210-220 recite polypeptides *comprising 30 or 50 contiguous amino acids* from SEQ ID NO: 2. The specification provides written description support for these species at, *inter alia*, page 31, line 27, to page 32, line 4. Applicants have not claimed polypeptides comprising 2, 5, or even 10 amino acids, nor have they provided reasoning to imply claims to polypeptides comprising 2, 5, or 10 amino acids.

The Examiner further asserts that "[w]hile the written description guidelines indicate that a molecule may be adequately described through a combination of structure and function, the degree of structure recited must also be considered." (Paper No. 12, at 5.) The Examiner asserts that the antibody-binding function of the unamended claims did "not provide adequate structure to meet the written description guidelines." However, the Examiner considered that Applicants arguments were persuasive for polypeptides that bind TRAIL.

Applicants have amended claims 176, 184, and 210 to recite polypeptides that bind TRAIL. The new elements of independent claims 176, 184, and 210 are incorporated into their respective dependent claims 177-183, 185-189, and 211-220. Thus, Applicants define the genera by reference both to a structural component and a functional component that was

deemed sufficiently specific by the Examiner. These amendments introduce no new matter, and their consideration and entry are respectfully requested.

For all of the above reasons, Applicants assert that the written description requirements have been met and that the Examiner's rejection is overcome. Accordingly, claims 176-190 and 210-220 are now in condition for allowance. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Rejections under 35 U.S.C. § 112, second paragraph, indefiniteness

The Examiner rejected claim 202 under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (Paper No. 12, at 6.) In particular, the Examiner questioned the base claim references. Applicants thank the Examiner for pointing out these minor errors. Applicants have followed the Examiner's suggestion and amended claims 202 and 203 to depend from claims 200 and 202, respectively. Thus, the Examiner's rejection has been overcome.

Other Matters

Applicants have amended claims 152, 161, 169 and 210 to correct minor clerical and typographical errors. These amendments introduce no new matter. Accordingly, their consideration and entry are respectfully requested.

Applicants thank the Examiner for allowing claims 117, 120-175, 191-197, 199, 201, and 203-209.

Applicants also thank the Examiner for consideration and entry of the amended sequence listing filed March 26, 2003, to which reference is made in the Advisory Action of April 9, 2003.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance or Appeal. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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Appl. No. 09/826,212



Version with markings to show changes made

In the Claims:

Pending claims 118, 119, 152, 161, 169, 176, 184, 194, 198, 200, 202, 203 and 210 were replaced by the following claims 118, 119, 152, 161, 169, 176, 184, 194, 198, 200, 202, 203 and 210:

118. (Once amended) The polypeptide of claim 117, wherein said polypeptide further comprises [comprising] amino acids -25 to 233 of SEQ ID NO:2.
119. (Once amended) The polypeptide of claim 118, wherein said polypeptide further comprises [comprising] amino acids -26 to 233 of SEQ ID NO:2.
152. (Once amended) The isolated polypeptide of claim 151, comprising the amino acid sequence of the complete TNFR5 encoded by the cDNA clone contained in ATCC Deposit No. 97788.
161. (Once amended) The polypeptide of claim 160, wherein the amino acid sequence is at least 95% identical to the amino acid sequence of the mature TNFR5 encoded by the cDNA clone contained in ATCC Deposit No. 97788.
169. (Once amended) The polypeptide of claim 168, wherein the amino acid sequence is at least 95% identical to the amino acid sequence of the complete TNFR5 encoded by the cDNA clone contained in ATCC Deposit No. 97788.
176. (Once amended) An isolated polypeptide comprising 30 contiguous amino acids from amino acids 1 to 233 of SEQ ID NO:2; wherein said polypeptide binds TRAIL [30 contiguous amino acids bind an antibody with specificity for a reference polypeptide consisting of amino acids 1 to 233 of SEQ ID NO:2].
184. (Once amended) An isolated polypeptide comprising 50 contiguous amino acids from -26 to 233 of SEQ ID NO:2; wherein said polypeptide binds TRAIL [50 contiguous amino acids bind an antibody with specificity for a reference polypeptide consisting of amino acids 1 to 233 of SEQ ID NO:2].
194. (Once amended) The polypeptide of claim 192, wherein the first amino acid sequence is (a).
198. (Once amended) The polypeptide of claim 196, wherein the first amino acid sequence is (b).
200. (Once amended) The polypeptide of claim 191, wherein said second amino acid sequence is (c).

202. (Once amended) The polypeptide of claim 200 [197], wherein said first amino acid sequence is (c).
203. (Once amended) The polypeptide of claim 202 [198], which comprises amino acids 27 to 123 of SEQ ID NO:2.
210. (Once amended) An isolated polypeptide selected from the group [the] consisting of:
 - (a) a polypeptide comprising 50 contiguous amino acids of the complete TNFR5 encoded by the cDNA contained in ATCC Deposit No. 97788;
 - (b) a polypeptide comprising 30 contiguous amino acids of the mature TNFR5 encoded by the cDNA contained in ATCC Deposit No. 97788;
 - (c) a polypeptide comprising 30 contiguous amino acids of the extracellular domain of TNFR5 encoded by the cDNA contained in ATCC Deposit No. 97788; and
 - (d) a polypeptide comprising the transmembrane domain of TNFR5 encoded by the cDNA contained in ATCC Deposit No. 97788;wherein said polypeptide binds TRAIL [an antibody with specificity for a reference polypeptide consisting of amino acids 1 to 233 of SEQ ID NO:2].